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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,737	10/02/2000	Curtis Cole	JBP525	3415

7590 11/19/2001
Philip S Johnson
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New Brunswick, NJ 08933-7003

EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1619

DATE MAILED: 11/19/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/677,737

Applicant(s)

COLE ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of the Amendment filed on August 27, 2001. Claims 1-16 are pending.

Claim Rejections - 35 USC § 112

Claims 7 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7 and 16 are rendered vague and indefinite by the term "natural plant extract" because this term, in and of itself, does not adequately delineate its metes and bounds.

Since the specification lacks any support for the types or examples of the plant extract to be used in the invention, examiner takes the position that a skilled worker would not have known what plants are to be used for the instant invention.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-16 are rejected under 35 U.S.C. § 102 (a) and (e) as anticipated by U.S. Pat. No. 6,162,419 issued to Perricone.

The rejection is maintained for the reasons of record.

Claim Rejections - 35 USC § 102/103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-16 are rejected under 35 U.S.C. § 102 (b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Pat. No. 5,643,586 issued to Perricone.

The rejections are maintained for the reasons of record.

Response to Arguments

Applicant's arguments filed on August 27, 2001, have been fully considered but they are not persuasive.

Applicant argues that the rejection lacks the basis of inherent characteristics of the prior art composition which applicant claims in the instant claims. Examiner respectfully disagrees. It is well established that if the composition is physically the same, it must have the same properties. See MPEP § 2112.01. The presumption of inherency in this case was based on the fact that Perricone teaches a topical composition comprising dimethylaminoethanol and tyrosine in the amount that overlaps with the limitation of the instant claims. In this case, the fact that ascorbyl acid is the active ingredient in '419 is irrelevant because the composition in the instant claims "comprising" tyrosine and alkanolamine also may contain active ingredients other than the recited components. If applicants' composition achieves different results than the composition of '419 or '586, which meets the instant claims, it may be due to some limitations not present in the claims.

Applicant argues that the method of instant invention is different from the prior art, asserting that a new use of known process, composition of matter, or material is patentable. Examiner views this argument unpersuasive. It has been held that when the claims recite using an old composition and the "use" is directed to a result or property of that composition, then the

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claim is anticipated. See In re May, 574, F.2d 1082, 1090, 197 U.S.P.Q. 601, 607 (C.C.P.A. 1978). In this case, examiner views that the use of a known topical composition to reduce redness or inflammation of skin by topically applying the composition is directed to a result or property of the composition, which does not amount to a "new use". See MPEP § 2112.02.

Thus, examiner maintains the position that the instant invention is anticipated by either '419 or '586.

Furthermore, In re Tomlinson, the court rejected the claims directed to a process of inhibiting light degradation of polypropylene by mixing it with one of a genus of compounds including nickel dithiocarbamate, over a reference which teaches mixing polypropylene with nickel dithiocarbamate to lower heat degradation. 363 F.2d 928, 150 U.S.P.Q. 623 (C.C.P.A. 1966). The court there held that the claims read on the obvious process of mixing propylene with dithiocarbamate, and the preamble of the claim was merely directed to the result of mixing the two materials. In this case, the instant claims are directed to a process of ameliorate redness or inflammation of skin by topically applying a composition comprising tyrosine and an alkanolamine, including dimethylaminoethanol. The '586 patent teaches topical composition comprising tyrosine and dimethylaminoethanol in the amount that overlaps with the limitation of the instant claims, and the use of the composition to treat subcutaneous muscle and the overlying skin. Thus, examiner maintains the position that the process of topically applying the known composition is obvious in view of the '586 patent, and the preamble, which recites the method of reducing redness or inflammation of skin, is merely directed to the result of the topical application of the composition, which does not render patentable weight in this case.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-305-3593.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
November 8, 2001


DIANA DUDASH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600